UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,374	12/04/2003	Randall Frank	08575-088001 / F-One Inte	6383

26161 7590 03/02/2007	EXAMINER
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022	SIKRI, ANISH

ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/728,374	FRANK ET AL.
	Examiner	Art Unit	
	Anish Sikri	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 December 2003</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-33 and 89</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-33 and 89</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>04 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/07/2004</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

Preliminary Amendment

The present Office Action is based upon the original patent application filed on

12/04/2003 as modified by the preliminary amendment filed on 04/29/2004. **Claims 1-**

33, and 89 are now pending in the present application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a

. foreign country or in public use or on sale in this country, more than one year

prior to the date of application for patent in the United States.

Claims **1-9, 11-23, 25-28, 30-31, 33 and 89** are rejected under 35 U.S.C. 102(b)

as being anticipated over Tang et al (US Pat 5,793,365).

Consider **Claim 1**, Tang et al clearly discloses a method comprising: receiving

from a first person a request to converse with a second person using any one of two or

more selectable communication modes (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2); and

in response to the received request, automatically performing an action determined by a

rule created by the second person (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2). Tang et

al clearly shows the method of a first person request to converse with second person in

the figures (Fig 1A, Fig 1B).

Consider **Claim 2**, Tang et al clearly discloses <u>a method of claim 1 wherein the</u> <u>rule is created by the second person using a user interface on a computing device</u> (Col 5 Lines 55-66, Col 6 Lines 1-10). Tang et al clearly shows the rules which can range from attentive, idle, engaged, do not disturb, and absent states (Col 5 Lines 55-66, Col 6 Lines 1-10).

Consider **Claim 3**, Tang et al clearly discloses a <u>method of claim 1 further</u> <u>comprising selecting the rule from a set of one or more rules based on a condition</u> <u>statement of the rule</u> (Col 5 Lines 55-66, Col 6 Lines 1-10). Tang et al clearly shows the rules which are based on a condition statement of the rule which can range from attentive, idle, engaged, do not disturb, and absent states (Col 5 Lines 55-66, Col 6 Lines 1-10).

Consider **Claim 4**, Tang et al clearly discloses <u>a method of claim 1 further</u> <u>comprising selecting the rule based on the one of two or more communication modes</u> (Fig 7, Col 3 Lines 59-67). Tang et al clearly shows the rules based on the one of the two or more communication modes such as chat (Fig 7, Col 3 Lines 59-67).

Consider **Claim 5**, Tang et al clearly discloses <u>a method of claim 1 further</u> <u>comprising selecting the rule based on an identity of the first person</u> (Col 5 Lines 55-66, Col 6 Lines 1-10). Tang et al clearly shows the rules which can range from attentive, idle, engaged, do not disturb, and absent states to the identify of the first person (Col 5 Lines 55-66, Col 6 Lines 1-10).

Consider **Claim 6**, Tang et al clearly discloses <u>a method of claim 1 further</u>

<u>comprising selecting the rule based on a current status of the second person</u> (Col 6

Lines 29-36, Col 7 Lines 29-55). Tang et al clearly shows on how rules affect the status

of the second person. Different types of icons are used to represent the various states

of user's status (Col 6 Lines 29-36).

Consider **Claim 7**, Tang et al clearly discloses <u>a method of claim 1 further</u>

<u>comprising determining an electronic document associated with the first person and</u>

<u>retrieving the electronic document if the second person indicates a desire to view the</u>

<u>document</u> (Col 9 Lines 42-50). Tang et al shows on how files and other data objects

are transferred between users (Col 9 Lines 42-50).

Consider **Claim 8**, Tang et al clearly discloses <u>a method of claim 7 further</u>

<u>comprising displaying the electronic document to the second person</u> (Col 9 Lines 42-50,

Col 10 Lines 33-36). Tang et al shows on how electronic documents are displayed

between users (Col 9 Lines 42-50).

Consider **Claim 9**, Tang et al clearly <u>discloses a method of claim 7 further</u>

<u>comprising retrieving the electronic document from an e-mail storage module, wherein</u>

<u>the electronic document is an e-mail message</u> (Col 8 Lines 6-10). Tang et al shows

that one of the methods of communication can indeed be in a form of an email between

users (Col 8 Lines 6-10).

Consider **Claim 11**, Tang et al clearly discloses <u>a method of claim 1 wherein</u>

<u>automatically performing the action further comprises enabling the first person to leave</u>

<u>a message if the current status of the second person is that the second person is</u>

<u>unavailable to converse</u> (Fig 1, Fig 2, Col 5 Lines 55-66, Col 6 Lines 1-10, Lines 27-37).

Tang et al clearly shows on how first person receives the status of the second person,

when the second person is unable to converse. Different types of icons are used to

represent the various states of user's status (Col 6 Lines 29-36).

Consider **Claim 12**, Tang et al clearly discloses a <u>method of claim 1 wherein</u>

<u>automatically performing the action further comprises forwarding the request to</u>

<u>converse to a third person if a current status of the second person is that the second</u>

<u>person is unavailable to converse and the third person is available to converse</u> (Fig 1,

Fig 2, Col 5 Lines 55-66, Col 6 Lines 1-10, Lines 27-37, Lines 51-62, Col 7 Lines 65-67,

Col 8 Lines 1-4). Tang et al clearly shows on how first person receives the status of the

second and third person, when the second person is unable to converse, but the third

person is available to converse. Different types of icons are used to represent the

various states of user's status (Col 6 Lines 29-36).

Consider **Claim 13**, Tang et al clearly discloses <u>a method of claim 1 wherein the</u>

<u>one of two or more communication modes comprises a voice conversation</u>

<u>communication mode</u> (Fig 11 – Audio-Conference 83, Col 4 Lines 15-22, Col 13 Lines

9-11, Col 14 Lines 46-57). Tang et al does show that one of the types of

communication modes can be in voice conversation mode with the use of microphone

and speakers (Fig 11 – Audio-Conference 83, Col 4 Lines 15-22, Col 13 Lines 9-11, Col

14 Lines 46-57).

Consider **Claim 14**, Tang et al clearly discloses <u>a method of claim 13 wherein the</u>

<u>voice conversation communication mode comprises Voice over Internet Protocol</u> (Fig 11

– Audio-Conference 83, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 46-57).

Tang et al clearly does show that one of the types of communication modes can be

carried out with the use of VOIP.

Consider **Claim 15**, Tang et al clearly discloses <u>a method of claim 1 wherein the</u>

<u>one of two or more communication modes comprises a voice/video conversation</u>

<u>communication mode</u> (Fig 11 – Audio-Conference 83, Video-Conference 81, Col 4

Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 40-57). One of the types of

communication can be carried out with the use of a web cam for voice/video

conversation mode.

Consider **Claim 16**, Tang et al clearly discloses <u>a method of claim 1 wherein the</u>

<u>one of two or more communication modes comprises a graphic text-based conversation</u>

<u>communications mode</u> (Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37).

Tang et al clearly a show one of the types of communication is in the form of chat mode,

which uses text-based conversation.

Consider **Claim 17**, Tang et al clearly discloses <u>a method of claim 16 wherein the</u>

<u>graphic text-based conversation communication mode comprises Instant Messaging</u>

(Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37). Tang et al clearly a show

one of the types of communication is in the form of chat mode, which uses text-based

conversation, therefore instant messaging.

Consider **Claim 18**, Tang et al clearly discloses a system <u>comprising: a</u>

<u>computing device comprising: a transceiver configured to receive a request to converse</u>

<u>with a user of the computing device; and an integration module configured to interact</u>

<u>with at least two of voice conversation software </u>(Fig 1A, Fig 1B, Col 15-16 Claim 1 and

2)<u>, voice-video conversation software </u>(Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2)<u>, graphic</u>

<u>text-based conversation software </u>(Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines

22-37)<u>, fax software, and electronic mail software </u>(Col 8 Lines 6-10)<u>, and to</u>

<u>automatically perform an action determined by a rule created by the user based on the</u>

<u>received request</u> (Tang et al, Col 12 Lines 61-67, Col 13 Lines 1-12). Tang et al clearly

shows the system capable of carrying out different types of communication methods.

Consider **Claim 19**, Tang et al discloses <u>the system of claim 18 wherein the</u>

<u>integration module comprises a microphone and a speaker </u>(Col 13 Lines 5-12, Col 7

Lines 3-8). The use of a microphone and a speaker is clearly shown.

Consider **Claim 20**, Tang et al discloses the system of claim 18 wherein the integration module comprises a user interface hook to detect when the user is interacting with the computing device (Col 15 Lines 13-22). The use of the activity manager detects when the user is interacting with the computing device.

Consider **Claim 21**, Tang et al discloses the system of claim 18 wherein the integration module comprises a user interface that enables the user to specify the action (Col 7 Lines 65-67, Col 8 Lines 1-14). Tang et al clearly shows on what type of action involving communicating with other users can be carried out.

Consider **Claim 22**, Tang et al discloses the system of claim 18 further comprising a network (Col 11 Lines 37-40). Various types of networks can be used.

Consider **Claim 23**, Tang et al discloses the system of claim 22 further comprising a second computing device configured to send the request to converse (Col 11 Lines 66-67, Col 12 Lines 1-8). Tang et al shows that a second computing device is required to send the request to converse with the users on the network.

Consider **Claim 25**, Tang et al discloses the system of claim 22 further comprising a switched local area network (Col 11 Lines 37-40). Various types of network can be used to communicate with the users.

Consider **Claim 26**, Tang et al discloses <u>the system of claim 25 wherein the</u>

<u>transceiver is further configured to receive a request to converse via the switched local</u>

<u>area network</u> (Col 13 Lines 5-12, Col 7 Lines 3-8, Col 11 Lines 37-40). Tang et al

clearly shows that the transceiver can be comprised of speakers and microphone

attached to the computing device.

Consider **Claim 27**, Tang et al discloses the system of claim 25 wherein <u>the</u>

<u>switched local area network is configured to connect the computing device to an</u>

<u>Internet</u> (Col 11 Lines 37-40). Various types of network can be used.

Consider **Claim 28**, Tang et al discloses the system of claim 25 wherein <u>the</u>

<u>switched local area network is configured to connect the computing device to an intranet</u>

(Col 11 Lines 37-40). It is inherent to use Intranet in a network that can easily be part of

a LAN.

Consider **Claim 30**, Tang et al discloses <u>the system of claim 29 wherein the</u>

<u>network further comprises a second switched local area network</u> (Col 11 Lines 37-40).

Various types of network can be used to communicate with the users.

Consider **Claim 31**, Tang et al discloses the system of claim 29, wherein <u>the</u>

<u>second computing device sends the request to converse via the second switched local</u>

<u>area network</u> (Col 11 Lines 66-67, Col 12 Lines 1-8). Tang et al shows that a second

computing device is required to send the request to converse with the users on the

network which can be on the second switched local area network.

Consider **Claim 33**, Tang et al clearly <u>discloses an article comprising a machine-</u>

<u>readable medium that stores executable instruction signals that cause a machine to:</u>

<u>receive, from a first person, a request to converse with a second person using any one</u>

<u>of two or more selectable communication modes</u> (Fig 1A, Fig 1B, Col 15-16 Claim 1 and

2); <u>and in response to the request, automatically perform an action determined by a rule</u>

<u>created by the first user</u> (Col 5 Lines 55-66, Col 6 Lines 1-10). Tang et al clearly shows

the method of a first person request to converse with second person in the figures (Fig

1A, Fig 1B). And Tang et al also shows the rules which can range from attentive, idle,

engaged, do not disturb, and absent states (Col 5 Lines 55-66, Col 6 Lines 1-10).

Consider **Claim 89**, Tang et al clearly shows the following <u>system comprising: a</u>

<u>computer device; a user interface that is configured to enable a user to interact with a</u>

<u>person using one of at least two of voice conversation</u> (Fig 1A, Fig 1B, Col 15-16 Claim

1 and 2), <u>voice-video conversation</u> (Fig 11 – Audio-Conference 83, Video-Conference

81, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 40-57), <u>graphic text-based</u>

<u>conversation</u> (Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37), <u>fax, and</u>

<u>electronic mail</u> (Col 8 Lines 6-10); <u>wherein the interaction comprises: creating a rule to</u>

<u>cause the computer device to automatically perform an action based on a request to</u>

<u>converse with the user</u> (Col 5 Lines 55-66, Col 6 Lines 1-10); <u>viewing an automatically</u>

generated listing of a set of persons, the listing comprising a name, presence information, and communication modes available for the user to communicate with the person from the set of persons (Col 5 Lines 55-66, Col 6 Lines 1-10).; selecting the person from the set of persons (Col 5 Lines 55-66, Col 6 Lines 1-10).; selecting a communication mode from the communication modes available to communicate with the person (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2); retrieving information about a person using an identifying characteristic of the person, where the identifying characteristic is selected by the user from a display (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2); and communicating with the person (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2). Tang et al clearly shows the system capable of carrying out different types of communication methods.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

2.   Ascertaining the differences between the prior art and the claims at issue.

3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating

obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 10, 24, 29, 32 rejected under 35 U.S.C. 103(a) as being unpatentable

over Tang et al (US Pat 5,793,365), and further in view of Rudy et al (US Pat

6,360,252).

Consider **Claim 10**, Tang et al in view of Rudy et al fails to disclose the method

of claim 7 further comprising retrieving a calendar of the second person from a calendar

storage module, wherein the electronic document is the calendar. But nonetheless,

Rudy et al clearly discloses the method of claim 7 further comprising retrieving a

calendar of the second person from a calendar storage module, wherein the electronic

document is the calendar (Rudy et al, Col 17, Lines 10-25). Therefore it would have

been obvious to a person of ordinary skill in the art at the time of the invention was

made to incorporate the use of a calendar taught by Rudy et al in Tang et al's method of

calendar retrieval, for the purpose of allowing users on the network to make their

schedules available for other users on the network to schedule appointments with them.

Consider **Claim 24**, Tang et al in view of Rudy et al fails to disclose the system of claim 22 further comprising a telephone configured to send the request to converse. Nonetheless, Rudy et al clearly discloses the system of claim 22 further comprising of a telephone configured to send the request to converse (Rudy et al, Col 26 Lines 20-24). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a telephone to send the request to converse in the application taught by Rudy et al in Tang et al's system, for the purpose of allowing users communicate via analog land telephone lines with each other.

Consider **Claim 29**, Tang et al in view of Rudy et al fails to disclose wherein the switched local area network is configured to connect to an Internet protocol/public switched telephone network gateway. Nonetheless, Rudy et al clearly discloses the switched local area network is configured to connect to an Internet protocol/public switched telephone network gateway (Rudy et al, Col 26 Lines 20-24). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a switched telephone network gateway to the LAN taught by Rudy et al in Tang et al's system, for the purpose of allowing users of the company to connect to the corporate network via the public telephone network gateway.

Consider **Claim 32**, Tang et al in view of Rudy et al fails to disclose the system of claim 31 wherein the network further comprises a telephone system and a public switched telephone network configured to enable the telephone to send the request to

converse to the computing device. Nonetheless Rudy et al clearly discloses the system
further comprises a telephone system and a public switched telephone network
configured to enable the telephone to send the request to converse to the computing
device (Rudy et al, Col 26 Lines 20-24). Therefore it would have been obvious to a
person of ordinary skill in the art at the time of the invention was made to incorporate
the use of a telephone to send the request to converse in the application taught by Rudy
et al in Tang et al's system, for the purpose of allowing users of the company to connect
to the corporate network via the public telephone network with aid of a telephone/fax
modem.

Conclusion

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

    Commissioner for Patents
    P.O. Box 1450
    Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

    Customer Service Window
    Randolph Building
    401 Dulany Street
    Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Anish Sikri whose telephone number is (571) 270-1783.

The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone

number for the organization where this application or proceeding is assigned is (571)

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist/customer service whose telephone

number is (571) 272-2600.

Anish Sikri
A.S./as

February 20, 2007

RAFAEL PEREZ-GUTIERREZ
SUPERVISORY PATENT EXAMINER
2/20/07